REMARKS

This Response is submitted in response to the Office Action dated January 30, 2004. Claims 1, 10 and 38 have been amended. Claims 3, 4, 12 and 13 are canceled without prejudice or disclaimer. Claims 2, 5, 11 and 14 stand previously canceled. Claims 15 to 37 stand withdrawn. No new matter has been added through these amendments.

No fee is due in connection with this Response. However, if a fee is due, please charge deposit account number 02-1818 for any insufficiency of payment.

The Office Action rejected Claims 1, 6 to 10, 12, 13 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff in view of Schwartz et al. and Koza. As discussed during the telephone interview, the Office Action considers Schwartz as two separate prior art references (i.e., the Let's Make A Deal ("LMAD") reference and the Sale of the Century ("SC") reference). Applicants respectfully disagree with these rejections because the Office Action fails to furnish a suitable justification or motivation for combining Yoseloff, LMAD, SC and Koza to form a proper basis for the §103(a) obviousness rejection. Additionally, certain of these claims have been amended to further clarify the existing elements of the claims.

Amended independent Claim 1 is directed to a gaming device having a game including an initial award selected from a first pool, the initial award offered to a player. The gaming device includes a plurality of masked awards, one of the masked awards being an enticement award selected from a second pool having values ranging so that the enticement award has a value greater than a value of the initial award, and one of the masked awards being a consolation award selected from a third pool having values ranging so that the consolation award has a value less than the value of the initial award. The gaming device also includes the first, second and third pools used repeatedly so that repeated play of the game provides information about ranges of the values of the pools, the values of the masked awards being disclosed to the player before the player chooses to keep the initial award or to select one of the masked awards, wherein each of the disclosed values is disclosed to the player without disclosing the association of each of the values with each of the masked awards and

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means for enabling the player to keep the initial award or to select one of the masked awards.

As stated in the Office Action, Yoseloff discloses a gaming device that entices players to risk an initial award in return for the opportunity to receiver a greater payoff in a second game segment during which a player chooses from several masked awards. For example, the player risks prizes obtained from a first game or event in the second game or the second event. (col. 2, line 62 to col. 3, line 2). In the second game, a player selects one of three doors to receive a prize, a neutral event (e.g., a push, loss of a percentage of the wager, gain of a small percentage of the wager, etc.) or a doubling or otherwise substantial increase in the wager award. The outcome associated with the selected door is provided to the player. Yoseloff does not disclose a gaming device with an initial award being selected from a first pool, a second award being selected from a second pool and a third award being selected from a third pool. Moreover, Yoseloff does not disclose a gaming device that discloses the values of at least one of the masked awards before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each masked award.

LMAD relates to a game show wherein a player may keep a known prize or trade the awarded prize for one of a number of unknown awards which are hidden from view. As stated in the Office Action, LMAD awards players prizes and offered the option of risking the initial prizes for one of several hidden prizes. As stated in the Office Action, the players did not know the values of the hidden prizes. LMAD does not disclose, teach or suggest disclosing the values of at least one of the masked awards before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each masked award.

As stated in the Office Action, SC relates to a game show wherein a player is awarded an initial prize and the given the option to trade the prize to select one of three hidden prizes. In SC, the player's were expressly informed of the hidden values, however the players did not know which value was associated with which hidden prize.

SC does not disclose, teach, or suggest an initial award being selected from a first pool, a second award being selected from a second pool and a third award being selected from a third pool.

As stated in the Office Action, Koza relates to a gaming device that includes a multi-level award pool system wherein predetermined outcomes are selected from different award pools to ensure appropriate distribution of the possible outcomes form each level. A first pool contains low-end awards, a second pool contains intermediate level awards and a third pool contains high-end awards. Koza does not disclose, teach, or suggest disclosing the values of at least one of the masked awards before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each masked award.

The Office Action states that when taken as a whole, Yoseloff, LMAD, SC and Koza suggest the claimed invention to an artisan. The Office Action further explains that it would have been obvious to modify Yoseloff with the features of LMAD, SC and Koza for the following reasons:

First, the Office Action argues that as demonstrated in LMAD, enticing players to risk a current award for the opportunity to win an award the player knows to be larger provides a time-proven way to add excitement and tension to a game of chance. Applicants respectfully disagree with this reason because enhancing player excitement and tension by enticing players to risk current awards for larger awards is a generic motivation applicable for a substantial number of gaming devices. While enticing players to risk current awards may enhance the player's excitement, the Office Action does not state a specific motivation in LMAD to select individual features from the other references to enhance the player's excitement as is achieved in the present invention.

Next, the Office Action argues that as demonstrated in SC, disclosing the values of the masked awards enhances the game by allowing players to use their knowledge of the potential outcomes to weigh the cost and benefit of risking their current award. The Applicants respectfully disagree with this reason because the Office Action does not provide a specific teaching, suggestion or motivation for this combination. The general

concept of adapting the features of a popular television game show into a gaming device does not make all gaming devices that are based on popular game shows unpatentable as obvious in light of the game show. The Office Action must show a specific teaching, suggestion or motivation for combining the specific references in the manner combined, rather than a general motivation that one general category of prior art (i.e., television game shows) can be combined with another category (i.e., gaming machines.) This is especially relevant in this application because the combination of references includes multiple different gaming device references combined with two different television show references. Without such specific teaching, motivation, or suggestion, the Office Action is using improper hindsight to reach such combination.

Applicants respectfully disagree with the reasons stated in the Office Action and submit that the Office Action does not set forth any specific motivation, incentive or suggestion contained in any of Yoseloff, LMAD, SC and Koza to select individual features from these references to achieve the present invention. Obviousness cannot be established by combining the prior art to produce the claimed invention absent some case law on teaching, motivation or suggestion supporting the combination. MPEP §2143.01; *In re Lee*, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). The Patent Office must show the "reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art" and combine those elements in the same manner as the claimed invention. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). These "reasons" need to be specific reasons, not general overarching reasons for combining two groups of references. There are three possible sources for determining whether a motivation to combine references exists: (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. MPEP § 2143.01; *In re Rouffet*, 149 F.3d at 1357. If there is no motivation to combine the cited references then the obviousness rejection is improper.

The Office Action does not satisfy any of these sources for combining the references cited. First, the Office Action does not show how it is obvious to combine the references in view of the nature of the problem to be solved. The problem the Office

Action refers to is the need to increase a player's level of excitement. However, as this is a problem generally common to gaming devices, it does not provide any specific or proper motivation to combine the cited references in the manner done so in the Office Action.

Second, the Office Action's explanations of the teaching of the prior art are not a proper motivation to combine the cited references. As explained above, the references cited do not discuss nor address the need to provide a gaming device which enables a player to keep an initial award or select one of a plurality of masked awards selected from a plurality of pools of different value ranges wherein the values of at least one of the masked awards are disclosed to the player before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each of the masked awards and wherein the pools are used repeatedly to provide information about the ranges of the values of the pools. While Yoseloff includes an initial award and a plurality of masked awards, Yoseloff does not disclose incorporating a plurality of different pools wherein the pools are used repeatedly to provide information about the ranges of the values of the pools. While LMAD includes an initial award and a plurality of masked awards, LMAD does not teach, motivate or suggest disclosing the values of at least one of the masked awards before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each masked award. While SC includes a plurality of masked awards and disclosing the values associated with each of the masked awards, SC does not teach, motivate or suggest an initial award being selected from a first pool, a second award being selected from a second pool and a third award being selected from a third pool. While Koza includes a multi-level award pool system, Koza does not teach, motivate or suggest disclosing the values of at least one of the masked awards before the player chooses to keep the initial award or to select one of the masked awards, wherein the value of the masked awards are disclosed to the player without disclosing the values associated with each

masked award. Thus, these four references each disclose in different combinations only certain features (but not all of the features) of the present invention.

Third, the knowledge of persons of ordinary skill in the art is not a proper motivation to combine the cited references in this application. While many of the features of the present invention may be known to persons of ordinary skill in the art, they have not been combined to result in a gaming device such as the present invention. Applicants respectfully submit that it is impermissible to use the claims as an instruction manual or "template" to piece together the teachings of the prior art to render a claimed invention obvious. *Sensonics, Inc. v. Aerosonic Corp.,* 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996). Virtually all inventions are combinations of old elements. *In re Rouffet* at 1457. An examiner may often find every element of a claimed invention in the prior art. However, rejecting patent claims solely by finding "prior art corollaries" for the claimed elements permits an examiner to use the claimed invention itself as a blueprint for piecing elements in the prior art together. *Id.* To defeat the patentability of a patent application in this manner is inappropriate. *Id.*

Moreover, as indicated above, Applicants submit that the Office Action improperly relies on hindsight reasoning as a justification for an obviousness rejection. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. MPEP §2145; *ATD Corp. v. Lydall,* 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998). When the Examiner fails to explain how the skilled artisan would have been specifically motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been made in hindsight, which is improper. *In re Gorman,* 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). That is, even if all its limitations could be found in the total set of elements contained in the prior art references, a claimed invention would not be obvious without a demonstration of the existence of a motivation to combine those references at the time of the invention. *Ecolochem, Inc. v. S. Cal. Edison Co.,* 227 F.3d 1361, 1371 (Fed. Cir. 2000). An Office Action cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. *Akzo N.V. v. United States ITC,* 808 F.2d 1471 (Fed. Cir. 1986). The notion

that claims can be deemed obvious merely upon finding similar elements in separate prior parts would necessarily destroy virtually all patents and defeat the congressional purpose in enacting Title 35. *Panduit Corp. v. Dennison Mfg. Co*, 810 F.2d 1561 (Fed. Cir. 1987). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to form the claimed invention." *In re Fine* , 837 F.2d 1071, 1075 (Fed. Cir. 1988). In this case, the Office Action improperly used hindsight reasoning by combining previously uncombined features from four separate references to conclude that a gaming device having the elements of amended independent Claim 1 is obvious. The Office Action is improperly picking and choosing individual elements from two separate gaming device patents and two separate game shows to form the gaming device of amended independent Claim 1. The Office Action is selectively picking specific elements from each of the four separate references without having a specific motivation for picking that element from each reference. This is an improper basis for the obviousness rejection of amended independent Claim 1.

Specifically, the Office Action: (1) selected Yoseloff and LMAD for an initial award and a plurality of masked awards, (2) selected Yoseloff and LMAD for enabling a player to keep the initial award or to select one of the masked award, (3) selected SC for disclosing the values associated with each of the masked awards and (4) selected Koza for a multi-level award pool system to recreate the elements of the gaming device of amended independent Claim 1. As described above, without a suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claim 1, the Office Action is improperly using hindsight reasoning as the basis for this obviousness rejection. For these reasons, Applicants respectfully submit that amended independent Claim 1 is patentably distinguished over Yoseloff, LMAD, SC and Koza and in condition for allowance.

Claims 6 to 9, depend directly or indirectly from Claim 1 and are also allowable for the reasons given with respect to Claim 1, and because of the additional features recited in these claims.

Applicants submit that none of Yoseloff, LMAD, SC or Koza discuss or address the specification combination of the elements of amended independent Claims 10 and 38. The Office Action used references that each include only certain elements of Claims 10 and 38, but these references do not teach, disclose or suggest the specific combination of the elements of Claims 10 and 38. Without any teaching, suggestion or motivation found either explicitly or implicitly in the references used to combine the references to form the specific combination of elements of Claims 10 and 38, the Office Action is improperly using hindsight reasoning as the basis for these obviousness rejection. For these reason and the reasons described above with respect to amended independent Claim 1, Applicants submit that Claims 10 and 38 are patentably distinguished over Yoseloff, LMAD, SC and Koza and in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicants respectfully request that the Examiner contact the undersigned to discuss this Response.

Respectfully submitted,

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